



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,605	02/12/2001	Kenneth L. Wright	DATCAR.003A	3816

20995 7590 07/02/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
----------	--------------

2175

DATE MAILED: 07/02/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary

Application No.

09/781,605

Applicant(s)

WRIGHT ET AL.

Examiner

DIANE D. MIZRAHI

Art Unit

2175

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

DIANE D. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

III. DETAILED ACTION

Claims 1-6, and 8-14 are presented for examination.

In response to communications filed on June 2, 2003, the Claims 1-6 and 8-14 are pending in the application. Applicant's arguments have been reconsidered but are not deemed persuasive for the reasons set forth below.

Response to Applicant's Remarks

Examiner has completed a through review and study of Applicant's amendment of June 2, 2003; especially, Applicant's remarks to claims 1-6 and 8-14 and remarks at pages 5-8. Applicant's remarks amendments to claims 1-6 and 8-14 further direct the claimed invention to personal information system. Examiner asserts that Teshima (US Patent No. 6,272,470 and Teshima hereinafter) in combination with Zubeldia et al. (US Patent No. 6,397,224 and Zubeldia hereinafter) and further in view of Feinberg (U. S. Patent # 6,415,295 and Feinberg hereinafter) teaches Applicant's new claimed invention of a personal information system. (See new Final Office Action cited below with the new claimed limitations rejected).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S. C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2) (a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Teshima (U.S. Patent # 6,272,470).

As to Claim 12, Teshima discloses a system for maintaining personal data, the system comprising: entering means for entering personal data (see Fig. 6, 120, write consultation records in a patient card); storing means for storing the personal data (see fig. 6, 1116 record name of consulting physician); accessing means for accessing the stored personal data (see fig. 6, 116 can select a consultation report from a list) wherein the accessing means comprises a PC with an optical disk drive (see Fig. 1, 11) and an Internet web browser (see

column 9, lines 40-53); transferring means for transferring the stored personal data between the entering means and the storing means in a secure mode (see column 8, lines 1-15, operators id is recorded and data encrypting/decrypting makes network safe); and updating means for updating the stored personal data (see column 5, lines 26-34, the updated consultation record is then written in the patient card and stored therein) wherein the updating means comprises using the Internet web browser (see column 9, lines 40-53).

Regarding Applicant's new claimed limitation of --

uniformly accessible manner . . . and . . . that interacts with the storing means so as to allow viewing of the stored personal data . . . --

Teshima teaches the claimed limitation of "uniformly accessible manner" (i.e. copy file in patient card) (Figure 9, #151) and the claimed limitation of "that interacts with the storing means so as to allow viewing of the stored personal data" (i.e. activate viewer) (Figure 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2175

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima (U.S. Patent # 6,272,470) in view of Zubeldia et al. (U.S. Patent # 6,397,224).

As to Claim 1, Teshima discloses a personal information system, comprising: a subscriber computer with an optical disk drive (see column 10, lines 17-21, in case of the optical card, data is input or output by way of a dedicated device driver); a portable optical disk readable by the optical disk drive (see column 10, lines 17-21, optical card, which reads on portable optical disk); a database management server comprising a database (see column 2, lines 15-20, medical information database) and an optical disk writer (see Fig 2, 13 optical input / output unit) wherein the optical disk writer writes the personal data to the portable optical disk (see column 1 lines 17-21 name address blood type etc are stored in the patient card).

Regarding Applicant's new claimed limitation of --

interacts with the subscriber computer so as to allow viewing of . . . wherein the Internet browser interacts with the database management server so as to allow updating of . . . --

Teshima teaches the claimed limitation of "interacts with the subscriber computer so as to allow viewing of . . . wherein the Internet browser interacts with the database management server so as to allow updating of" (i.e. an image server 2, and two electronic clinical recording systems 3 are interconnected on a local area network (LAN) 4 on the premises. In the other hospital B, an electronic clinical recording system 3 is connected on a local area network (LAN) 4 on the premises. The LANs 4 in hospitals A and B are linked to the Internet 5, whereby both the LANs can communicate with each other) (col 6, lines 49-58) and the claimed limitation of "subscriber" (i.e. inputting login names and passwords, a method of reading operator ID cards, a method of inputting operator's fingerprints, and a method of specifying operator's faces through taking photographs thereof with cameras etc. (col 16, lines 1-8)).

As to Claim 2, Teshima as modified discloses wherein the personal data to be stored on the portable optical disk is

selectable using the subscriber interface (see fig. 6, 113 can select a consultation report from a list).

As to Claim 3, Teshima as modified does not teach wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode.

Zubeldia et al. teaches wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode (see fig 1 and 2, subscriber computer reads on 18, and database server 84, as it creates encoded identity reference from the input to the output data).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima as modified wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima as modified with the teachings of Zubeldia et al wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode because the HIPAA establishes severe penalties for "wrongful disclosure" of health information that

is individually identifiable. (Zubeldia et al. column 1, lines 57-60).

As to Claim 4, Teshima as modified discloses wherein the transfer of personal data between the subscriber computer and the database management server can be initiated by either the subscriber computer or the database management server (see column 16, lines 37-67 and column 17, lines 1-33, image data can be initiated by the physician for consultation and the image data can also be film digitalized and downloaded to the server where image data reads on personal data) the data transfer occurring either in a real-time mode or a batch mode (see column 5, lines 26-34, the consultation records are stored into the patient card at any time or as a batch job).

As to Claim 5, Teshima as modified discloses wherein the personal data comprises text, image, audio, and video data (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled).

As to Claim 6, Teshima discloses method of maintaining personal data on a portable optical disk (see column 10, lines 17-21), the method comprising: writing the personal data onto the portable optical disk wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21)

using an Internet web browser interface; and delivering the portable optical disk to a subscriber (delivering the disk can be accomplished by handing the card to a patient or by mail which is well known).

Zubeldia et al. teaches entering personal data onto a database management server wherein the personal data is stored in the database management server (see fig 2, database server 54, as identifying element of the input data must be entered in the database and column 5, lines 26-34, a name, a birth date, an address, a ZIP code, a telephone number, a healthcare identifier).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima to include entering personal data onto a database management server wherein the personal data is stored in the database management server.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Zubeldia et al to include entering personal data onto a database management server wherein the personal data is stored in the database management server because it allows to identify an individual to whom the

Art Unit: 2175

patient record pertains to (Zubeldia et al. column 5, lines 26-34).

Regarding Applicant's new claimed limitation of --

"uniformly accessible manner and wherein the personal data residing on the database management server can be updated using an Internet web browser interface" and "optical disk writer..."

Teshima teaches the claimed, "...uniformly accessible manner" (i.e. copy file in patient card) (Figure 9, #151) "... server . . . " (col 16, lines 50-59)... "... updating ... " (i.e. When the patient has come for the first medical care, the "new creation mode" is selected to form an input table of consultation records based on the basic information stored in the patient card. At this time, the name of a medical institution, the year and date of occurrence, and an examining doctor's name are automatically registered and displayed) (col 16, lines 12-26) and "optical disk... " (i.e. CD-ROM, floppy disk, portable disk, mini-disk, or magneto-optical disk, files are used according to the DOS format that conforms to the ISO standards and is a de facto standard format and can be constructed as a file system (col 10, lines 11-16)).

As to Claim 7, **(NOW CANCELED AS PER AMENDMENT OF 6-2-03)**

(Teshima as modified discloses wherein the personal data residing on the database management server can be updated using the Internet web browser interface (see Fig. 1, if an Xray is taken at Hospital B then only way to store the digitalized film is to go through the internet

Art Unit: 2175

and see column 16, lines 37-67 and column 17, lines 1-33, the image data can also be film digitalized and downloaded to the server where image data reads on personal data).

As to Claim 8, Teshima as modified discloses wherein the personal data to be updated is selectable by the subscriber (see fig. 6, 113 can select consultation report from a list to be updated).

As to Claim 9, Teshima as modified does not teach wherein entering, writing, and updating the personal data are in an HIPAA compliant mode.

Zubeldia et al. teaches wherein entering, writing, and updating the personal data are in an HIPAA compliant mode (see column 7, lines 17-49, new records are assigned a new code and update records reuse the same code).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima as modified wherein entering, writing, and updating the personal data are in an HIPAA compliant mode.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima as modified with the teachings of Zubeldia et al wherein entering, writing, and updating the personal data are in an HIPAA compliant mode because the HIPAA establishes severe penalties for "wrongful disclosure" of health information

that is individually identifiable. (Zubeldia et al. column 1, lines 57-60).

As to Claim 10, Teshima as modified discloses using the portable optical disk at any healthcare service center to prevent repetitious registration process at different healthcare service center sites (see Fig. 1, same patient card can be used at Hospital A and B without further registration).

As to Claim 11, Teshima as modified discloses wherein the portable optical disk is created at the health care service center site (see column 3, lines 27-52, an individual keeps a portable storage medium functioned as a clinical recording as a health care/medical care card when consulting at a medical institution implies the card must be created at or with the consent of the health care service center as the card must conform to HTML or SGNIL formats).

Claims 13 and 14 are rejected under 35 U.S. C. 103(a) as being unpatentable over Teshima (U.S. Patent # 6,272,470) in view of Feinberg (U.S. Patent # 6,415,295).

As to Claim 13, Teshima discloses a portable optical disk (see column 10, lines 17-21, optical card, which reads on portable optical disk) comprising personal data, wherein the

Art Unit: 2175

personal data comprises demographics (see column 1, lines 17-21, name address), medical data (see column 1, lines 6-8) and conditions of admission (see column 3, lines 16-26, consultation record) in formats including text, images, audio, and video (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled) wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 1721) using an Internet web browser interface (see column 9, lines 40-53).

Teshima does not teach wherein the personal data comprises living will and power of attorney.

Feinberg teaches wherein the personal data comprises living will and power of attorney (see column 5, lines 39-53, living will reads on donor, power of attorney reads on directives).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima wherein the personal data comprises living will and power of attorney.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Feinberg wherein the personal data comprises living will and power of attorney

because it allows access to medical information in case of emergency (Feinberg column 1, lines 57-60).

Regarding Applicant's new claimed limitation of --

"uniformly accessible manner and wherein the personal data residing on the database management server can be updated using an Internet web browser interface" and "wherein . . . updateable Internet web . . ."

Teshima teaches the claimed, "...uniformly accessible manner" (i.e. copy file in patient card) (Figure 9, #151) ". . . server . . . " (col 16, lines 50-59)... "... updating ... " (i.e. When the patient has come for the first medical care, the "new creation mode" is selected to form an input table of consultation records based on the basic information stored in the patient card. At this time, the name of a medical institution, the year and date of occurrence, and an examining doctor's name are automatically registered and displayed) (col 16, lines 12-26) and "optical disk... " (i.e. CD-ROM, floppy disk, portable disk, mini-disk, or magneto-optical disk, files are used according to the DOS format that conforms to the ISO standards and is a de facto standard format and can be constructed as a file system (col 10, lines 11-16). (See Also, (i.e. an image server 2, and two electronic clinical recording systems 3 are interconnected on a local area network (LAN) 4 on the premises. In the other

Art Unit: 2175

hospital B, an electronic clinical recording system 3 is connected on a local area network (LAN) 4 on the premises. The LANs 4 in hospitals A and B are linked to the Internet 5, whereby both the LANs can communicate with each other) (col 6, lines 49-58) and the claimed limitation of "subscriber" (i.e. inputting login names and passwords, a method of reading operator ID cards, a method of inputting operator's fingerprints, and a method of specifying operator's faces through taking photographs thereof with cameras etc. (col 16, lines 1-8)).

As to Claim 14, Teshima discloses a personal data management system comprising: a portable optical disk (see column 10, lines 17-21, optical card, which reads on portable optical disk) comprising demographics (see column 1, lines 17-21, address), medical data (see column 1, lines 6-8), living will, power of attorney, and conditions of admissions (see column 3, lines 16-26, consultation record) in formats including text, images, audio, and video (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled) wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21) using an Internet web browser (see column 9, lines 40-53); and a database management server comprising an optical

Art Unit: 2175

disk writer and a database wherein the database contains the personal data to be written to the portable optical disk using the optical disk writer (see Fig 1, image database, contains images to be recorded on the card).

Teshima does not teach wherein the personal data comprises living will and power of attorney.

Feinber teaches wherein the personal data comprises living will and power of attorney (see column 5, lines 39-53, living will reads on donor, power of attorney reads on directives).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima wherein the personal data comprises living will and power of attorney.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Feinber wherein the personal data comprises living will and power of attorney because it allows access to medical information in case of emergency (Feinber column 1, lines 57-60).

Regarding Applicant's new claimed limitation of --

"personal data store... Uniformly accessible . . . wherein .
. . . database management server . . . updateable . . . web
browser . . ."

Regarding these limitation noted above, these limitations are similar in scope to the rejected claims above and are therefore rejected as set forth above.

Examiner asserts that Barber and Teshima and Zubeldia in combination with Feinberg teaches Applicant's invention.

Examiner maintains that the Examiner has established a *prima facie* case of obviousness", "obviousness determination requires an evaluation of whether prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art" and that "recited subject matter would not have been obvious to one of ordinary skill in the art based upon the applied patents", the arguments has been fully considered but are not found to be persuasive, because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But, so long as it takes into account only knowledge which was within the level or ordinary skill at the time of the invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such as reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant is inaccurate for the reasons explicitly stated in the first Office Action dated 2-27-2003 and this new office action.

Applicant's remarks are considered moot, and does not place the application in condition for allowance. Examiner asserts that "every limitation positively recited in a claims was given effect in order to determine what the subject matter that the claim defines" In re Wilder, 166 USPQ 545, 548 (CCPA 1970) and that Examiner believes that claims 1-6 and 8-14 are not allowable over the prior art of record cited in the First Office Action dated 2-27-03 and this new final office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2175

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is (703) 305-3806. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (703) 305-3806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-9000 for regular communications and (703) 305-9000 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9001.



Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

June 28, 2003